

## REMARKS

This amendment is made in response to the First Office Action dated October 10, 1996 and after detailed telephonic discussions with the Examiner. These discussions have been very helpful and are appreciated.

### *The Examiner's Rejections*

In this Office Action, the Examiner rejected independent claim 55, under 35 U.S.C. § 102(e), as being anticipated by the Champa's US patent 5,315,633, as follows:

As per claim 55, Champa teaches a teleconferencing system essentially as claimed having a first network for data [fig.4 #53], comprising:

- an AV path [fig.4] to a second work station [another station as in fig.4] via a third location [control hub fig.5, see col.7 lines 34-40];
- first, second codecs [fig.4 #41], and third codecs [fig.5 #75] at said first, second and third locations configured to compress AV signal;
- an AV switch [fig.5 switch #57] at the third location operable to route compressed AV signals to other locations without said compressed AV signals being decompressed by said third codec [apparent from col.6 and fig.5 - from fig.5, it is clear that the third codec (76) only code/decode signal for the link 75. All other signal would pass through the switch untouched by the codec 76].

Independent claim 196 and certain dependant claims were also based on rejected Champa.

***Applicant's Response***

In response and without prejudice, Applicants have cancelled certain claims, amended others and added others. In particular, even though Applicants believe claims 55 and 196 are patentable, these claims have been replaced with two new independent claims 207 and 218.

Applicants also present the following comments in support of patentability:

***The Champa reference does not teach the claimed invention.***

Contrary to the Examiner's assertions, Champa does not anticipate the invention claimed in the now cancelled claims 55 and 196.

1. **Champa does not show at least the network switch at the third location.** The digital video switch (DVS) 57 shown in Champa's Fig. 5 is controlled "*by a single coordinator/space operator.*"<sup>1</sup> Thus a human makes the connections in the Champa arrangement not the switch.<sup>3</sup>

2. **Champa does not teach the unique signal routing.** In the claims, a signal is routed from a first location to the intended second location via a third *non-destined* location. Signals destined for the second location are not reproduced at the third location. Champa describes exactly the opposite: "the outgoing video signal is to be transmitted to *all*

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<sup>1</sup> Col 6, lines 24 to 25 of the Champa patent. Emphasis added.

<sup>3</sup> See, for example, Col 3, lines 40 to 44; the "keyboard controls" mentioned at Col 3, lines 58 to 61; Col 4, lines 2 to 5; and Col 6, lines 1 and 2.

teleconferencing sites." (Emphasis added)<sup>4</sup> Thus, Champa connects only participating locations to each other and contains no indication that a signal is ever received at and routed by a non-participating location. There is no indication that the Champa operator would or could control a video conference between two remote sites and, most importantly, that the signals from those sites could be routed via the manually controlled DVS 57.

Accordingly, Champa does not teach the apparatus or method of the cancelled independent claims. Nonetheless, Applicants cancelled these claims and added new independent claims with still further limitations in an endeavor to expedite allowance. These are made without admission to the relevance of the prior art.

***Champa does not suggest all claim elements.***

Should the Examiner wish to rely on Champa to establish an obviousness rejection, the onus is on the Examiner to show that Champa *teaches or suggests* the claimed configuration.<sup>5</sup>

But, this cannot be done.

Champa teaches a manually controlled switching system in which all "locations" are participating in the controlled video conference. Applicant cannot see how this disclosure can contain the essential teaching or suggestion to make the claimed combination with a

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<sup>4</sup> Col 8, lines 6 and 7 of the Champa patent.

<sup>5</sup> *In re: Royka*, 490 F.2d 981, 180 USPQ 580 CCPA 1974 as cited in the MPEP § 143.03.

*Response Amendment*

reasonable expectation of success.<sup>6</sup> For how can one be led to the invention, and have a reasonable expectation of success, by the Champa reference, a reference that does not consider routing via a "non-participating" location and that uses a manually operated switching system.

*Champa cannot be combined with other references.*

The Examiner may, instead, argue that the AV signal routing feature could be derived from other art areas and combined with the Champa teaching. In particular, the Examiner may wish to point to data routing art. This argument will also fail for the reasons given before in the supplemental amendment mailed on September 19, 1996.

For all the above reasons, therefore, Applicants, submit that the independent claims are allowable. Accordingly, the dependant claims are also believed allowable and the Examiner's rejection of these claims need not be directly addressed.


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<sup>6</sup> *In re Vaack*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991) as cited in the MPEP § 2142.

*Response Amendment*

Applicants, therefore, request allowance of these claims at the Examiner's earliest convenience. Should the Examiner believe a further conference will expedite the allowance of this application, please contact the undersigned.

Respectfully submitted,

  
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